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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,922	06/27/2003	Ravindra K. Pandey	25886-0094	8140
20985	7590	11/02/2004		
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081				
			EXAMINER NWAONICHA, CHUKWUMA O	
			ART UNIT 1621	PAPER NUMBER

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/607,922

Applicant(s)

PANDEY ET AL.

Examiner

Chukwuma O. Nwaonicha

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-28, 30-43, 50-61, 63-76, 82-94, 96-109 & 117-124 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 3-8, 25-28, 56, 58-61, 84, 89, 91-94 and 117 is/are rejected.
- 7) ☒ Claim(s) 9-23 and 122-124 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

Continuation of Disposition of Claims: Claims withdrawn from consideration are 1-2, 24, 30-43, 50-54, 57, 63-76, 82, 83, 85-88, 90, 96-109 and 118-121.

DETAILED ACTION

Claims 3-28, 30-43, 50-61, 63-76, 82-94, 96-109 and 117-124 are pending in the application.

Election/Restrictions

Applicants' election with traverse of Group 1 (claims 3-23, 25-28, 56, 58-61, 84, 89, 91-94, 117 and 122-124) in the reply filed on 8/6/04 is acknowledged. The traversal is on the ground(s) that claims 3-23, 25-28, 56, 58-61, 84, 89, 91-94, 117 and 122-124 are related. Applicants argue that Groups 2 (claims 24, 57 and 90) is directed to an article of manufacturing which incorporate a compound according to Group 1 (claims 3-23, 25-28, 56, 58-61, 84, 89, 91-94, 117 and 122-124). As such, the claims are related as combination/subcombination. In addition, applicant pointed out that if the restriction requirement is maintained, that applicant should be granted multiple patents that will expire on different dates, each of which would include claims that overlapping subject matter, where the latter issuing patents should not be held to constitute obviousness-type double patenting. Finally, applicants' argue that linking claims have been improperly restricted from claims directed to a species of a genus claimed by the linking claims.

The traversal is not found persuasive because the inventions of claims 3-23, 25-28, 56, 58-61, 84, 89, 91-94, 117 and 122-124 and the inventions of claims 24, 30-43, 50-54, 57, 63-76, 82, 83, 85-88, 90, 96-109 and 118-121 are related as product and method of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) that the process for using the product as claimed can be

practiced with another materially different product or (2) that the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process of using the product as claimed can be practiced with another materially different product, such products are disclosed in US 5,952,366, US 6103,751, US 5864035 and US 5770,730, for example.

The requirement is still deemed proper and is therefore made **FINAL**.

Claims 24, 29-55, 62-83, 85-88, 90, 95- 116 and 118-121 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Groups, there being no allowable generic or linking claim. All claims consisting of Group 1: claims 3-23, 25-28, 56, 58-61, 84, 89, 91-94, 117 and 122-124 will be examined on the merits. The Examiner agrees with applicants that they are entitled to file divisional applications to the non-elected claims.

Applicants' are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

Applicants' claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

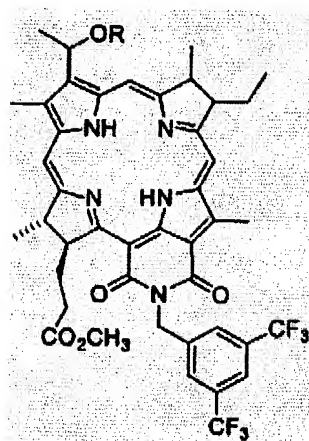
Claims 3-8, 25-28, 56, 58-61, 84, 89, 91-94 and 117 are rejected under 35 U.S.C. 102(a) as being anticipated by Li et al., {Application for Ruppert's Reagent in Preparing Novel Perfluorinated Porphyrins, Chlorins and Bacteriochlorins, J. Chem. Soc., Perkin Trans. 1, 1999, 1785-1787}.

Li et al. disclose porphyrin compounds as claimed. See page 1786, formulas 7, 8, 18a and 18b.

Allowable Subject Matter

Claims 9-23 and 122-124 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The fluorinated photosensitizers related to chlorines and bacteriochlorins for photodynamic therapy were neither found to be obvious nor anticipated by the prior art of record.

The prior art does not teach or suggest the presently claim fluorinated compounds such as the elected species shown below (figure I) for detection, diagnosis and treatment of target tissues or target compositions, including hyperproliferative tissues such as tumors that uses photodynamic methods:



I

wherein R is a butyl group.

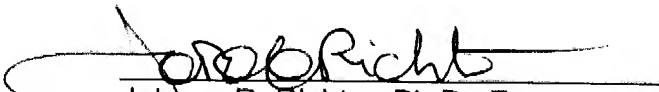
No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chukwuma O. Nwaonicha whose telephone number is 571-272-2908. The examiner can normally be reached on Monday thru Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit: 1621



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